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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/755,856

01/12/2004

Maurice Gell

UCT-0040

8424

23413

7590

02/05/2008

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EXAMINER

SAVAGE, JASON L

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

02/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/755,856 | <b>Applicant(s)</b><br>GELL ET AL. |  |
|                              | <b>Examiner</b><br>JASON L. SAVAGE   | <b>Art Unit</b><br>1794            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23, 25-38, 40 and 43-68 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 19-21, 23, 25-38, 40, 45-62 and 65-68 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 63 is/are allowed.
- 6) ☒ Claim(s) 64 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 43 and 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

Previously amended and newly submitted claims 16, 19-21, 23, 25-31, 33-38, 40, 45-52, 59-60 and 65-68 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The previously examined claims as originally filed were drawn to a material comprising splats having an average diameter of less than or equal to about 2 micrometers.

The originally elected invention and the inventions in the claims recited above are directed to related products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have a different design such as the new claims are silent to the material having any splats. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16, 19-21, 23, 25-31, 33-38, 40, 45-52, 59-60 and 65-68 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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It was noted in Applicant's response that they wished to elect presently presented claims 16, 19-21, 23, 25-31, 33-38, 40, 45-52, 59-60 and 65-68 for prosecution in this Application. However, as recited above, these claims are drawn to an invention which is distinct from the originally presented invention and as such have been withdrawn. Should Applicant wish to have these claims examined, a <sup>Divisional</sup> ~~continuation~~ of the present Application could be a suitable means to have the invention examined.

As such, the only claims which are presently pending and not withdrawn are claims 17-18, 43-44 and 63-64.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 64 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There does not appear to be a basis for limitation that "greater than or equal to about 90% (emphasis added) of the splats...." in the application as originally filed.

While Applicant recites that "about 80 to about 95%" of the splats have the recited

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diameter, there is no disclosure to support the limitation of "about 90%" such as recited in claim 64.

***Allowable Subject Matter***

Claim 63 is allowed.

Claims 17-18 and 43-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 11-27-07 have been fully considered but they are not persuasive.

**Election/Restriction Requirement**

Applicant states that they hereby elect the invention of withdrawn claims 16, 19-21, 23, 25-31, 33-38 drawn to a material or coating comprising at least one inter pass boundary having a porosity within the claimed range. The Examiner presumes Applicant intended to <sup>include</sup> ~~include~~ withdrawn claims 45-52, 59-60 and 65-68 which are drawn to a similar invention.

As set forth in the action above, Applicant has already received an action on the merits for the originally presented (emphasis added) invention, this invention has been constructively elected by original presentation for prosecution on the merits. Applicant

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cannot elect an invention which is materially distinct from the originally presented invention at this point in prosecution. Should Applicant wish to pursue an invention drawn to the invention recited in withdrawn claims 16, 19-21, 23, 25-31, 33-38, 40, 45-52, 59-60 and 65-68 a <sup>divisional</sup> ~~continuation~~ of the present Application could be a suitable means to have the invention examined.

### 35 USC 103(a) Rejection

The amendment to claim 59 and subsequently its dependent claim 64 has overcome the rejection to claim 64 in view of the cited prior art. However, claim 64 is rejected under 35 USC 112 first paragraph for containing subject matter which was not described in the application as originally filed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON L. SAVAGE whose telephone number is (571)272-1542. The examiner can normally be reached on M-F 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jason Savage  
1-31-08



KEITH D. HENDRICKS  
SUPERVISORY PATENT EXAMINER